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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,065	08/26/2003	Jeffrey M. Alaimo	101990025005	2935

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EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/648,065

Applicant(s)

ALAIMO ET AL.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8,10-13,15,16,29-31 and 35-54 is/are pending in the application.
- 4a) Of the above claim(s) 52-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-42,46 and 47-48 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,10-16 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 4,7,29-31,49 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Withdraw of Finality**

1. The finality of the previous Office action, dated June 2, 2005 has been withdrawn after consideration of the Request for Reconsideration filed by the applicant on June 23, 2005. An Office action on the merits of the claims appears below.

### ***Election/Restrictions***

2. Newly submitted claims 52-54 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims include a package and details directed to the package which were not previously claimed. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 52-54 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. This election is hereby made **FINAL**.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 3 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ravitz et al. 2002/0071597. Ravitz '597 discloses all the limitations of the claims including the following: stocking a predetermined number of sets of foot orthotics (orthotics are stocked according to arch height, i.e. stack with arch height A, stack with arch height B, stack with arch height C); each set having a standard arch

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height that is unique for that set (sets done by arch heights); measuring an arch height of a sole of a foot (see paragraph [0041]); selecting an orthotic from the set for which the standard arch height most closely matches the measured arch height (see paragraph [0034]); the predetermined number of sets is only three (three different arch heights A, B, C); the measuring step includes determining the arch height from a footprint of the sole (see paragraphs [0046] and [0047]); stocking foot orthotics of different arch heights (orthotics are stocked according to arch height, i.e. stack with arch height A, stack with arch height B, stack with arch height C); measuring an arch height of a sole of a foot (see paragraph [0041]); selecting, from the stocked orthotics, an orthotic of which the arch height most closely matches the measured arch height (see paragraph [0034]).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ravitz et al. 2002/0071597 as applied above in view of Potter 5,879,725. Ravitz et al. '597 as applied above discloses all the limitations of the claim except for the orthotics being heat-softened and conforming to the shape of the sole. Potter '725 teaches that orthotics (inserts) placed within a shoe can be heat-softened (as the shoe is) and reformed to conform to the size and shape of the shoe of the shoe for better fit for the user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to heat-soften the orthotic of Ravitz et al. '597 while placing it in the shoe to allow it to conform to the sole for better fit to the user's foot.

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7. Claims 6, 8, 10, 11-13, 15-16 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dribbon 5,678,566. Dribbon '566 discloses all the limitations substantially as claimed including the following: engaging the sole of a foot against a thermal imaging device 12 to obtain from the device a thermal image of the sole; determining a characteristic of the sole based on the thermal image (see col. 4, lines 36-43); the imaging device includes a thermally sensitive material that exhibits a change in color with a change in temperature (see col. 4, line 58-col. 5, line 2); the imaging device is in the form of a plate configured to lie flat on the ground (see Figures 2 and 3, device is "in the form of a plate" as it appears to be plate-like) and the engaging step includes stepping on the device (see Figure 3, there is no limitation that says the plate is on the ground and stepped on); the determining step includes determining pressure points of the sole based on the thermal image (see col. 5, lines 12-40); determining step includes determining restricted blood flow locations of the sole based on the thermal image (see col. 5, lines 24-27).

Dribbon '566 does not specifically state that the foot is engaged with the thermal imaging device while the foot is not in the shoe. Dribbon '566 can perform in this fashion since the thermal imaging device is removable from the shoe and includes the type of material disclosed by applicant for applicant's thermal imaging device. Therefore, it would have been obvious to use the device of Dribbon outside a shoe as well as inside the shoe to determine the problem areas of the user's foot. Furthermore, Dribbon does not specifically teach either heating or cooling the user's sole as compared to the thermal imaging device. Dribbon teaches that the thermal imaging device is based on a temperature difference between the user's foot and the temperature of the device, therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to heat or cool the user's foot or the device, by any means known for heating or cooling, to get a temperature different reading between the user's sole and the device.

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With respect to claims 43-45, the warming of the sole of the foot has been addressed immediately above, as well as the standing on the device (see Figure 3) and the change in color in response to the change in temperature.

***Allowable Subject Matter***

8. Claims 35-42 and 46-47 are allowed over the prior art of record.
9. Claims 4, 7, 29-31 and 49-50 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments with respect to some of the claims have been considered but are moot in view of the new ground(s) of rejection. All of applicant's arguments have been responded to in the rejections set forth above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS